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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GOLDMAN, MICHAEL H

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,150	Applicant(s) OHNO ET AL.	
	Examiner MICHAEL H. GOLDMAN	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/1/08, 10/7/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following Non Final Action is in response to the amendment filing on December 10, 2008. Claims 1-11 have been amended. Therefore, Claims 1-11 are pending and have been considered below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph as being confusing.

Specifically, in independent claim 1 and 8, the preamble of the claim recites a **system**, indicating structure, means plus function or Hardware, whereas the body of the claim recites data structure or software per se, which is not statutory. Further, for claim “a determining portion for determining...”, ‘an information transmission portion for transmitting...’, and for claim 8 ‘a determining portion for determining...’ and ‘a notification portion for sending...’ represent software, as disclosed in the specification, not means or Hardware. Additionally, the claim changes statutory class since the preamble talks about a system, while the body recites software per se, which renders the claims confusing under 35 U.S.C. 112(2).

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph as being confusing.

Specifically, in independent claim 9 and dependent claims, the preamble of the claim recites an **apparatus** indicating structure, means plus function or Hardware, whereas the body of the claim recites data or software per se, which is not statutory. In other words, a user registration, information delivery, delivery status management and notification subroutines represent software, as disclosed in the

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specification, not means or Hardware. The claim changes statutory class since the preamble talks about a system, while the body recites software per se, which renders the claims confusing under 35 U.S.C.

112(2). In other words, independent claim 1 changes from a statutory class (subject matter), in the form of a system as recited in the preamble, to a non-statutory subject matter or class, in the form of software per se as recited in the body of the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject.

Specifically, in independent claim 1 and 8, the preamble of the claim recites a **system**, indicating structure, means plus function or Hardware, whereas the body of the claim recites data structure or software per se, which is not statutory. Further, for claim “a determining portion for determining...”, ‘an information transmission portion for transmitting...’, and for claim 8 ‘a determining portion for determining...’ and ‘a notification portion for sending...’ represent software, as disclosed in the specification, not means or Hardware. Additionally, the claim changes statutory class since the preamble talks about a system, while the body recites software per se, which renders the claims confusing under 35 U.S.C. 112(2).

7. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject.

Further, in independent claim 9, the preamble of the claim recites an **apparatus**, indicating structure, means plus function or Hardware, whereas the body of the claim recites data structure or software per se, which is not statutory. Specifically, a determining portion and an information transmission portion as defined in the specification, represent software, not means or Hardware. Additionally, the claim changes statutory class since the preamble talks about an apparatus, while the body recites software per se, which renders the claims confusing under 35 U.S.C. 112(2).

8. Claim 10 and the dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, a **method**/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to a particular machine or apparatus nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Also see, United State Court of Appeals for the Federal Circuit, 2007-1130,

(Serial No. 08/833,892)
IN RE BERNARD L. BILSKI
and RAND A. WARSAW.

For example in independent claim 10, the steps of “making a provider information storage...”, “determining whether or not...”, and “transmitting the provision information...”, etc. should individually incorporate a particular machine (computer, apparatus or hardware per se);

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otherwise it can be concluded, under a broad interpretation, that those steps were manually performed. Here, to be statutory, under USC 101, each individual step should incorporate or should be performed using a particular machine (computer, apparatus or hardware per se).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4, and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel et al. (7,370,004).

1/8-11

Claims 1 and 10-11: Patel et al. discloses an information brokerage method and system comprising:

-a user information storage portion for storing provider area information and provision information for each information provider, the provider area information indicating an area designated by the information provider, and the provision information to be provided by the information provider, a determining portion for determining whether or not an area indicated by the user area information, - an information transmission (delivery) portion for transmitting the provision information (see abstract, lines 1-20 whereby a management repository storing information concerning the user and further storing information concerning a plurality of information/products/services to

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offer the user and a personalization engine for making decisions (determining portion) as to which provision information to provide to a user, and whereby the information system is coupled to the communication channel (information transmission portion) and whereby the user having a communication device for communicating over the channel, examiner construes area information as inherently included in the user and provider profiles).

Claim 4: Patel et al. discloses the invention as in claim 1 above. Patel et al. further discloses the feature wherein the provision information storage portion stores category information in association with the provision information, the user information storage portion stores category information desired by the user, and the information transmission portion transmits the provision information if a category of contents of the provision information is included in a category of information desired by the user (see rejection under claim 1).

Claim 8: Patel et al. discloses an information brokerage system comprising:

-a *user information storage* portion for storing provider area information and provision information for each information provider, the provider area information indicating an area designated by the information provider, and the provision information to be provided by the information provider, a *determining portion* for determining whether or not an area indicated by the user area information, - an *information transmission* (delivery) portion for transmitting the provision information (see abstract,

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lines 1-20 whereby a management repository storing information concerning the user and further storing information concerning a plurality of information/products/services to offer the user and a personalization engine for making decisions (determining portion) as to which provision information to provide to a user, and whereby the information system is coupled to the communication channel (information transmission portion) and whereby the user having a communication device for communicating over the channel, examiner construes area information as inherently included in the user and provider profiles);

a notification portion for sending notification to a terminal device of the user according to the user area information so that the user receives the provision information of the information provider according to the provider area information (see abstract, line 18-20 whereby the plurality of information/product/services to present to the user over the communication channel based on the stored information in the knowledge management repository (examiner interprets plurality of information et al. to present user over communication channel as notification, also see column 3, line 30-41, and column 4, lines 42-46).

Claim 9: Patel et al. discloses a server that is connected to an information brokerage system comprising:

-a user registration portion for receiving an application from the user for information delivery so as to register the user as an information delivery destination user (see column 7, lines 52-54 whereby the present invention provides a means to

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personalize an interaction via various communication channels between a customer (user) and a provider, examiner construes a means to personalize an interaction as including a user registration portion for receiving an application from the user for information delivery, also see column 8, lines 3-15);

An information delivery *portion* for sending information a terminal device of the user according of the user area information so that the user receives the provision information of the information provider according to the provider area information (see Fig 8 for server and interconnection to user (10) see abstract, line 18-20 whereby the plurality of information/product/services to present to the user over the communication channel based on the stored information in the knowledge management repository (examiner interprets plurality of information et al. to present user over communication channel as notification, also see column 3, line 30-41, and column 4, lines 42-46); and

-a delivery status management portion for managing delivery status of information to the provider (see column 8, lines 21-31).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (7,370,004).

Claim 3: Patel et al. discloses the invention as in claim 1 above. However he fails to explicitly disclose the feature comprising a movement information obtaining portion for obtaining movement information that indicates a speed and a direction of movement of the user to support the determining portion.

The New York City Subway system has been using mobile/wireless technology with a centralized command center (370 Jay Street, Brooklyn, NY) to determine the speed and location of their subway cars since the 1960's and provide appropriate communications directly with the 'motormen' (train engineers).

Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Patel et al. to include a speed and direction of movement of user portion to determine when to transmit provisioning information to a user. One would have been motivated to do so in order to select

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information providers that the user has not already passed, e.g. when driving on the Interstate.

Claims 6 and 7: Patel et al. discloses the invention as in claim 1 above. However he fails to explicitly disclose the feature wherein the provision information includes information for advising an application for receiving information delivery from the information provider and comprising a delivery status management portion for managing a delivery status of information that is delivered directly from the information provider to the user, and an accounting information generation portion for counting delivery statuses of the information at a predetermined timing so as to generate accounting information to the information provider.

However, Official Notice is taken that it is old and well known to keep customers informed on the delivery status of an order. For example, both FedEx and UPS delivery services have provided user with up-to-date information pertaining to the expected delivery date and time since they were first established. Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Patel et al. to include the features of information for advising an application for receiving information delivery from the information provider and comprising a delivery status management portion for managing a delivery status of information that is delivered directly from the information provider to the user, and an accounting information generation portion for counting delivery statuses of the information at a predetermined timing so as to generate accounting information to the

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information provider. One would have been motivated to do so in order to allow the user to anticipate and prepare for the delivery of the information.

12. Claims 2, 3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Taschereau (20040076279)

Claims 2 and 5: Patel et al. discloses the invention as in claim 1 above.

However he fails to explicitly disclose the feature wherein the provision/segmented information storage store provider location information, the user information storage portion stores user location information and the information transmission portion transmits the provision information if a distance between a location of the information provider who provides the provision information to be transmitted and a location of the user who is a destination of the transmission is smaller than the distance designated by the user.

However, Taschereau discloses a method and system for providing geographically targeted information and advertising wherein the provision/segmented information storage store provider location information ,the user information storage portion stores user location information and the information transmission portion transmits the provision information if a distance between a location of the information provider who provides the provision information to be transmitted; and a location of the user who is a destination of the transmission is smaller than the distance designated by the user (see [0008], lines 1-12 and also see [0038], lines 3-6 whereby the system

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returns the described location or a collection of references representing street blocks within the given area (within distance designated by user).

Therefore, it would have been obvious in view of Taschereau for a person having ordinary skill in the art at the time of the invention to modify the invention of Patel et al. to include a distance of provider/provider information to user designated distance to initiate transmission of the provision information. One would have been motivated to do so in order to satisfy customer travel distance requirements so as to increase the transaction rate, i.e. provide information about an information provider within a reasonable distance from the user.

Response to Arguments

13. Applicant's arguments filed December 10, 2008 have been fully considered but they are not persuasive.

Applicant argues "...claims 1 and 8 are directed to a system---and not to either of a computer software program or software modules." Examiner respectfully disagrees, since each of the principal elements of a system claim must be specifically tied to an apparatus based upon Supreme Court precedent cited above in the U.S.C. 101 rejections above.

Applicant argues for Claim 1 and 4 "However, Patel et al. fails to disclose the recitations of claim 1 as amended, i.e. 'an information transmission portion that transmits the provision information of the information provider according to the provider area information to a terminal device of the user according to the user area information

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if it is determined that the area indicated by the provider area information overlaps the area indicated by the user area information.' (Emphasis Added)". Examiner respectfully disagrees, since Patel et al. customized content from its own repository, and other static and dynamic transactions systems (see column 12, lines 10-12) and employs dissemination via a multi-channel, multi-action system (see column 9, line 26) which employs mobile devices (see column 9, line 64, telephone, examiner interprets to include mobile/cellular devices; also see column 13, line 28-37 whereby the user is identified via the channel/device by which the system is accessed, examples include hand held devices, ATMs, Kiosks etc.). The personalization/customization of content would address geographic (area) of the user as indicated by such content as (local) weather and product information (see column 13, lines 56-59).

Applicant argues for Claim 9 "However, Patel et al. fails to disclose the recitations in claim 8 as amended, i.e. 'a notification portion that sends a notification to a terminal device of the user according to the user area information so that the user receives the provision information of the information provider according the provider area information if it is determined that the area indicated by the provider area information overlaps the area indicated by the user area information; and an information transmission portion that transmits the provision information of the information provider to the terminal device of the user responding t a request from the user who received the notification.' ((Emphasis Added)". Examiner respectfully disagrees, in addition to the argument provided above for Claim 1 and 4 which applies to claim 9, the extent of the overlap of a (geographic) area is a designer preference which is not given any patentable weight,

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and examiner also interprets the customization by Patel et al. to include designer preferences.

Applicant argues "...Patel et al. fails to disclose the recitations in claim 11 as amended, i.e. 'transmitting the provision information corresponding to the provider area information to a terminal device of the user according to the user area information if it is determined that the area indicated by the provider area information overlaps the area indicated by the user area information.' (Emphasis Added)". Examiner respectfully disagrees; see rationale provided above for same arguments.

Applicant argues "However, Patel et al. fails to disclose, at least, the recitations claimed in claim 1, as amended; claims 2, 3, and 5-7 inherit those recitations and thus are not obvious." Examiner respectfully disagrees, and has addressed these arguments above for claim 1.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herz et al. (6571279) discloses a location enhanced information delivery system.

Powers (20020097193) discloses a system and method to increase the efficiency of outdoor advertising.

Stewart (6452498) discloses a system and method for providing geographic-based advertising.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MG/
February 18, 2009

/Jean Janvier/

Primary Examiner, Art Unit 3688